

**35 U.S.C. 121:**

**The inventions stated are:**

**I - Claims 1 through 5, drawn to a method of making a magnetically pinned layer, classified in class 427, subclass 128, and**

**II - Claims 7 through 17, drawn to a method of making a magnetic head, classified in class 29, subclass 603.13.**

**III - Claims 18 through 31, drawn to a product of magnetic head, classified in class 360, subclass 324.11.**

**Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1 through 5, drawn to a process classified in Class 427, subclass 128. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.**

**The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.**

**The Examiner gives the reasons for the distinctness between Groups I and II and Group III as (1) that the process as claimed can be used to make other and materially**

different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of forming "a magnetically pinned layer", and that the product claims are directed to "a magnetically pinned layer", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 427/128 and product class/subclass 360/324.11, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, the product of Group III can be made by a materially different process, such as one that patterns by using mechanical machining techniques, without the need for a cocontact mask or lift-off mask, as required by Groups I and II." is speculative and has nothing to do with the Claims as presented in this patent application.

The Examiner further states that Groups II and I are related as combination and subcombination, and gives as the reasons for distinctness that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). However, upon reading the Invention II Claims against the Claims of Invention I, it can be seen that Invention II is drawn to "a process to manufacture a magnetic read head," while Invention I is drawn to "a method to form a magnetically pinned layer". As such, the field of search must necessarily cover both the Group I class/subclass 427/128

and the Group II class/subclass 29/603.13 in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, the combination (Group II) as claimed does not require the particulars of the subcombination (Group I) as claimed because Group II does not require the specifics of depositing a layer of magnetic material, as required by Group I. The subcombination has separate utility such as depositing a layer of magnetic material. " is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'SBA', with a stylized flourish extending to the right.

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